UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,952	09/26/2001	Toshihide Hida	1122.65856	1582

7590 11/24/2006	**EXAMINER**
Patrick G. Burns, Esq.	VAN DOREN, BETH
GREER, BURNS & CRAIN, LTD.	

ART UNIT	PAPER NUMBER
3623	

Suite 2500
300 South Wacker Dr.
Chicago, IL 60606

DATE MAILED: 11/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 September 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>7-11,13-17,19-23 and 25-27</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>7-11,13-17,19-23 and 25-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 09/05/2006 has been entered.

2.   Claims 12, 18, and 24 have been canceled. Claims 7, 9, and 19 have been amended.

Claims 25-27 have been added. Claims 7-11, 13-17, 19-23, and 25-27 are now pending in this

application.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 7-9, 13-15, 19-21, 25, and 27 are rejected under 35 U.S.C. 102(e) as being

anticipated by Bilbrey et al. (U.S. 2002/0103932).

As per claim 7, Bilbrey et al. teaches a computer readable medium storing a program to

cause a computer to perform message-address management processing in a system capable of

exchanging messages among a plurality of servers and clients, wherein the program causes a

server computer to perform:

when a message address of a member of a message exchanging group is changed,

absence response information including at least an old address and a new address of the member

is caused to be received from the client (See paragraph 83, where updates of a recipient's address

is provided. See also paragraphs 7-8, 10, 46-7, and 63-4, where a member of a group of

recipients in a message system changes his/her address and this information is sent by the client

to the server. See also figures 20-21, where a recipient specifies his old and new address as well

as with whom this information can be shared);

determining, from a plurality of provided message address lists, a message address list

including the old address of the member, and extracting message addresses of the rest of the

members of the determined message address list (See paragraphs 58, 80, 85-9, wherein an

address list is communicated and used to substantially update the "sponsors" email address list.

Email addresses are received and matched against old email addresses. The members that are

not the member whose address is changing are obtained and the member along with other

members in the list with old addresses are obtained, and updated. See also paragraphs 55, 61,

63-4, 68);

specifying a server to which the absence response information is to be provided, on the

basis of the extracted message addresses (See paragraphs 7-8, 10, 46-7, 55, 59, and 85-9, where

the network server has information concerning address changes, and the "sponsor" interacts with

this server based on the information contained in its list); and

distributing the absence response information to the specified server (See paragraphs 7,

55, 59, wherein the network server and the sponsor communicate to provide and receive the

information).

As per claim 8, Bilbrey et al. discloses wherein the absence response information

contains a period of validity of the absence response information (See paragraphs 112 and Table

3, where the determination is made as to whether addresses are valid. See also paragraphs 61

and 68, wherein the address information is time stamped, to show the time at which the date

become valid and up to date).

As per claim 9, Bilbrey et al. teaches wherein a plurality of pieces of the absence

response information to be distributed to the same server are gathered together for distribution

See paragraph 58, wherein the information to be distributed to the sponsor is gathered together at

the server for distribution to the sponsor based on the list and the Reconnection Manager).

Claims 13-15 recite substantially similar subject matter to claims 7-9, respectively, and

are therefore rejected using the same art and rationale set forth above.

Claims 19-21 recite substantially similar subject matter to claims 7-9, respectively, and

are therefore rejected using the same art and rationale set forth above.

As per claims 25 and 27, Bilbrey et al. discloses wherein absence response information

includes a flag indicating whether the absence response information is to be provided to a mail

server administrator (See paragraph 0080, wherein an indication is sent by an administrator to

receive absence information (i.e. undeliverable addresses and/or all addresses)).

5.   Claims 10-11, 16-17, and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated

by Reilly (U.S. 2003/0135567).

As per claim 10, Reilly teaches a computer readable medium storing a program to cause a

computer to perform message-address management processing in a system exchanging messages

among a plurality of servers and clients, wherein the program causing the computer to perform:

receiving, from a server, absence response information including at least an old address

and a new address of a member of a message exchanging group (See paragraphs 0013-4, 0028,

0058, wherein a user supplies, via his computer system and server, information concerning an

old address and a new address to a forwarding server);

when receiving a message to be transmitted to another server, judging whether or not an

original address of the received message matches the old address contained in the absence

response information (See paragraphs 0013-4, 0010, 0032-4, 0056, wherein the server receives a

message to be transmitted between a sending and receiving server, where it is determined

whether the destination address is a proper address (i.e. registered address is current or is an old

address registered in the system));

replacing the original address of the message with a new address associated with the old

address matching the original address (See paragraphs 0014, 0017-8, 0028, 0051-7, 0059,

wherein the old address is replaced with a new address);

transmitting the message using the replaced address, which is the new address in the

absence response information (See paragraphs 0012-4, 0017-8, 0056-9, 0062, wherein the

message is sent to the new address based on the registration with the system).

As per claim 11, Reilly teaches that when the message has been transmitted to the new

address, notifying a requestor of the message transmission that the message has been transferred

to the new address (See paragraph 0062, wherein the requester is notified of the new address).

Claims 16-17 recite substantially similar subject matter to claims 10-11, respectively, and

are therefore rejected using the same art and rationale set forth above.

Claims 22-23 recite substantially similar subject matter to claims 10-11, respectively, and

are therefore rejected using the same art and rationale set forth above.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

7.   Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly (U.S.

2003/0135567) in view of Bilbrey et al. (U.S. 2002/0103932).

As per claim 26, Reilly discloses an electronic mail management system that manages the

forwarding of electronic mail based on absence information (See paragraph 0001, paragraphs

0013-4, 0028, 0058). However, Reilley does not expressly disclose an administrator or a flag

indicating whether the absence response information is to be provided to a mail server

administrator.

Bilbrey et al. discloses wherein absence response information includes a flag indicating

whether the absence response information is to be provided to a mail server administrator (See

paragraph 0080, wherein an indication is sent by an administrator to receive absence information (i.e. undeliverable addresses and/or all addresses)).

Both Reilly and Bilbrey et al. disclose systems that manage changes and updates to users email addresses. Reilly discloses an electronic mail management system that manages the forwarding of electronic mail based on absence information, such as when a user changes employer (see paragraph 0013). Bilbrey et al. discloses an administrator providing indication that absence information about email addresses is required. It would have been obvious to one of ordinary skill in the art at the time of the invention to send an indication to the employers in Reilly by an administrator to request address absence information in order to more efficiently provide accurate and efficient email services by maintaining up to date lists concerning current email addresses. See paragraphs 0001, 0010-3, of Reilly and paragraphs 0002, 0055, and 0080 of Bilbrey et al.

Response to Arguments

8.   Applicant's arguments with respect to claims 10-11, 16-17, and 22-23 have been considered but are moot in view of the new grounds of rejection.

9.   Applicant's arguments with regards to rejections of claims 7-9, 13-15, and 19-21 have been fully considered, but they are not persuasive. In the remarks, Applicant argues that Bilbrey et al. does not teach or suggest specifying a server to which the absence response information is to be provided, on the basis of the extracted message address.

In response to this argument, Examiner respectfully disagrees. Bilbrey teaches sending the absence response information to the server and updating the appropriate databases based upon where the request originated from, as discussed in at least paragraph 55. See also

paragraphs 7-8, 47, 59, and 85-9, where the network server has information concerning address

changes, and the "sponsor" interacts with this server based on the information contained in its

list. That specific sponsor is therefore the "specified" server to receive the absence information.

See also paragraphs 10, 46, and 59, which specifically state that the user can specify sponsor

servers which are and are not allowed to receive the address updates. Examiner notes that claims

7, 13, and 19 merely recite "specifying a server", but does not specifically recite what this

entails. Therefore, in the broadest reasonable interpretation of this limitation, specifying could

mean that the user restricts the servers that can receive the address, but could also mean that the

servers that query for address updates are specified (i.e. identified or indicated) to receive the

information (such as a request is identified to receive an answer). As per Applicant's comments

on page 9, Bilbrey et al. does not automatically provide information to all servers (supported by

paragraphs 10, 46, and 59).

Further, on page 11, Applicant states that the server is specified on the basis of the

extracted message address, which is not the same as that which is taught by Bibrey et al.

However, since the sponsor is the one who provides a massage address list containing old

addresses to the system for updates, and thus provides the list from which the addresses are

extracted, examiner asserts that Bilbrey et al. does specify a server based on this extraction. See

paragraphs 58, 80, 85-9, wherein an address list is communicated and used to substantially

update the "sponsors" email address list. Email addresses are received and matched against old

email addresses. The members that are not the member whose address is changing are obtained

and the member along with other members in the list with old addresses are obtained, and

updated. See also paragraphs 55, 61, 63-4, 68.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Krause et al. (U.S. 2002/0059142) teaches an electronic change of address system.

McDowell et al. (U.S. 2006/0010214) discloses where new email addresses are provided to an old ISP so messages can be forwarded.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Van Doren whose telephone number is (571) 272-6737. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Bvd
November 21, 2006

Beth Van Doren
Patent Examiner, AU 3623